

Rec'd PCT/PTO 11 JAN 2005

10/520977

PTO/SB/64/PCT (12-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number
(Optional)
56266US009

First Named Inventor: Hudd, Alan L.

International (PCT) Application No.: PCT/US02/15774

U.S. Application No.:
(if known)

Filed: May 16, 2002

Title: Inkjet Maintenance Kit

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee
- (2) Proper reply
- (3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity - fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status.
See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,500.00 (37 CFR 1.17(m))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of
A Request to Enter National Phase (identify type of reply):

☐ has been filed previously on _____

☒ is enclosed herewith.

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Sale Ref: 00000005 DO# 133723 10520977

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is derived (and is derived) from an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the USPTO Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

☒ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Carolyn A. Bates

Signature

January 11, 2005

Date

Carolyn A. Bates

Typed or Printed Name

27,853

Registration Number, if applicable

3M Innovative Properties Company, 3M Center

Address

651-733-1523

Telephone Number

P.O. Box 333427, St. Paul, MN 55133-3427

Address

Enclosures: ☒ Response

☒ Fee Payment (Deposit Account # 13-3723)

☐ Terminal Disclaimer

☒ Other (please identify): Additional sheets containing statements establishing unintentional delay

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Customer Number

Rec'd PGT/PTO 11 JAN 2005

Patent
Case No.: 56266US009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE 10/520977

First Named Inventor: HUDD, ALAN L.

International PCT/US02/15774

Group Art Unit: Unknown

Application No.:

Filed: May 16, 2002

Examiner: Unknown

Title: INKJET MAINTENANCE KIT

PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being:

- ☒ deposited with the United States Postal Service on the date shown below with sufficient postage as "Express Mail Post Office to Addressee" addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

January 11, 2005
Date

Signed by: Colleen M. Wagner

Dear Sir:

Enclosed is a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b); a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 USC § 371 with duplicate; a Preliminary Amendment; a Declaration and Power of Attorney, For Utility or Design Patent Application (37 CFR § 1.63); a Recordation Form Cover Sheet with duplicate; and an Assignment of Application.

Please charge the petition fee under 37 CFR § 1.17(m) and any additional fees which may be required to Deposit Account No. 13-3723. The entire delay in filing the required reply from the due date until the filing of this petition was unintentional. For the Examiner's benefit, a statement of the facts regarding the unintentional abandonment of the above-mentioned patent application is provided below.

STATEMENT OF FACTS

1. An agreement was executed between 3M Company and 3M Innovative Properties Company (collectively "3M"), and Xennia Technology Limited ("Xennia") on December 9, 2002, which had an effective date of January 1, 2001. This agreement was for development work completed by Xennia at 3M's expense for an ink-jet printing system. This agreement also involved the assignment of patent rights from Xennia to 3M, including the PCT patent application referenced above. Also in this agreement, 3M granted Xennia an exclusive license under the patent rights in certain fields, and there was a provision that if 3M proposed to abandon any patent rights, then 3M would first notify Xennia of its intention and give Xennia a period of two (2) months to request 3M to assign the patent rights, which it was

proposing to abandon, to Xennia. If Xennia requested that such patent rights be assigned to them, then Xennia would be responsible for the future prosecution of the patent rights. If Xennia did not request that such patent rights be assigned to them, then 3M would be free to abandon the patent rights.

2. 3M has an agreement tracking system in its legal department for storage of legal agreements. All intellectual property-related agreements are scanned and abstracted for future searching and tracking by personnel in the legal department. If an agreement involves patent applications or issued patents, those patent rights are also "flagged" in the legal department's docketing system. For example, particular patent applications may be marked with an "abandonment blocked" status on the docketing system, if 3M is unable to abandon the patent applications without first seeking the consent of a third party. If a business unit decides to abandon a patent application, the docketing clerk first checks the docketing system to see if there are any abandonment blocks on the docketing system for that patent application. If there are no abandonment blocks on the docketing system for that patent application, then the docketing clerk sends a letter to the prosecuting attorney to discontinue prosecution of the patent application.
3. Unfortunately, the agreement between 3M and Xennia was unintentionally not recorded in 3M's agreement tracking system and as a result, the patent applications referenced in the agreement, including the PCT patent application referenced above, unintentionally did not receive an "abandonment blocked" status on 3M's docketing system.
4. On September 22, 2003, the business unit responsible for the PCT patent application decided to discontinue prosecution of the patent application. However, both the business unit and the attorney responsible for the business unit were not aware of the agreement between 3M and Xennia, due to the fact that the agreement was not stored in the agreement tracking system.
5. Sometime between September 22, 2003 and October 28, 2003, the docketing clerk searched the docketing system to see if there were any abandonment blocks on the system related to the PCT patent application and found none. On October 28, 2003, the docketing clerk mailed a letter to 3M's prosecuting attorney of the PCT patent application at Vossius & Partner, located in Germany, communicating that 3M decided to discontinue prosecution of the PCT patent application referenced above.
6. On February 19, 2004, 3M was mailed a communication from the European Patent Office that the PCT patent application referenced above was withdrawn for failure to pay the appropriate fees within the specified time.
7. On October 12, 2004, Xennia contacted 3M wanting to know why 3M had not notified Xennia of 3M's intention to abandon the PCT patent application, and had not given Xennia a period of two (2) months to request 3M to assign the PCT patent application to Xennia before 3M abandoned the PCT patent application, per the agreement. A copy of the agreement was sent by Xennia to 3M, and 3M started its investigation into why the agreement was not located on the agreement tracking system. As soon as 3M identified the reason for the unintentional abandonment, 3M started the process to revive the patent applications referenced in the agreement, including the PCT patent application referenced above.

Favorable consideration of the petition is respectfully requested.

Respectfully submitted,

January 11, 2005

Date

By: Carolyn A. Bates

Carolyn A. Bates, Reg. No.: 27,853

Telephone No.: (651) 733-1523

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833